

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant : Donald F. Hamilton et al.
Serial No. : 08/777,958
Filed : December 24, 1996
Title : VEHICLE TRUNK WOOFER

Art Unit : 2644
Examiner : Daniel Swerdlow
Conf. No. : 4029

Mail Stop Appeal Brief - Patents

Honorable Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

REPLY TO SUPPLEMENTAL EXAMINER'S ANSWER

WE CITED THE BOSE '588 PATENT ONLY TO SHOW THAT AT LEAST AS EARLY AS 1956 THERE WERE FOUR-INCH LOUDSPEAKERS, ANY ONE OF WHICH COULD BE USED TO EMBODY THE INVENTION BY PLACING IT IN THE VEHICLE TRUNK IN ACCORDANCE WITH THE DESCRIPTION.

The Supplemental Examiner's Answer relies on the 1959 Bose patent that covered the BOSE 2201 loudspeaker system for use in a room whereas the invention disclosed and claimed in this application deals with a vehicle low frequency loudspeaker system that enables a small loudspeaker that occupies negligible trunk volume to coact with the trunk volume to achieve good low frequency response in the vehicle. The '588 patent describes "utilizing twenty-two standard Carboneau four-inch loudspeakers", Column 7, lines 16-17. We cited this patent to show that four-inch loudspeakers were well known, at least as early as 1956, any one of which could be placed in the trunk, preferably in the rear corner as clearly disclosed in the description. Manifestly, any person skilled in the art of vehicle loudspeaker systems could make and use the invention by placing a single four-inch loudspeaker in the rear corner of a vehicle trunk in accordance with the description in this application.

The '588 patent is concerned with radiation in a room that has a volume considerably greater than that of a vehicle interior. There is not a column, paragraph, sentence, clause, phrase or word in that patent which can be regarded as evidence overcoming the clear disclosure in the description that enables any person skilled in the art of vehicle loudspeaker systems to make and use the invention.

In rejecting a contention "that the patentee had failed to describe his invention in such full, clear, and exact terms as to enable persons skilled in the art to construct and use it," the Supreme Court said, "When the question is, whether a thing can be done or not, it is always easy to find persons ready to show how not to do it." *Loom Co. v. Higgins*, 105 U.S. 580, 586 (1881). That is what the Examiner has done here in the lack of enablement rejection. In contrast, the disclosure of this application is enabling in showing how to do it.

CONCLUSION

In view of the authorities and reasoning advanced in our Brief and the inability of the prior art to anticipate, suggest or make obvious the subject matter as a whole of the invention disclosed and claimed in this application, the decision of the Examiner finally rejecting claims 1, 3-6 and 8-10 should be reversed. Should the Board be of the opinion that one or more of the rejected claims may be allowed in amended form, the Board is respectfully requested to include a specific statement that a claim may be allowed in such an amended form and direct that application owner shall have the right to amend in conformity with such statement which shall be binding on the Examiner in the absence of new references or grounds of rejections.

Respectfully submitted,
FISH & RICHARDSON P.C.

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/charles hieken/
Charles Hieken
Reg. No. 18,411
225 Franklin Street
Boston, MA 02110
Telephone: (617) 542-5070
Facsimile: (617) 542-8906
Attorneys for Applicant